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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,270

04/26/2006

Dominic Berta

FE 6143 (US)

2471

34872 7590 05/12/2010  
BASELL USA INC.  
NEWTOWN SQUARE CENTER  
3801 WEST CHESTER PIKE, BLDG. B  
NEWTOWN SQUARE, PA 19073

EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/12/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,270	<b>Applicant(s)</b> BERTA ET AL.	
	<b>Examiner</b> Jeffrey Lenihan	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to the appeal brief filed on 12/18/2009.
2. The finality of the Office Action mailed on 3/30/2009 is withdrawn.
3. The amendment filed on 7/06/2009 has been entered into the record.
4. The objections and rejections not addressed below are deemed withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Claim Rejections - 35 USC § 103***

6. Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelliconi et al, WO 03/051984 (of record), in view of Winter et al, US5145819 (of record).
7. The disclosures of Pelliconi and Winter are discussed in the Office Actions mailed on 3/30/2009 and 7/09/2008, incorporated herein by reference.
8. As discussed in the previous Office Actions, Pelliconi discloses that crystalline propylene (co)polymer component of the composition of WO 03/051984, corresponding to claimed component (a), is made using a Ziegler-Natta catalyst which comprises a titanium halide compound such as  $\text{TiCl}_4$  and an electron donor compound, both on an  $\text{MgCl}_2$  support, as well as an organoaluminum co-catalyst such as triethylaluminum and an external electron donor compound. Pelliconi further teaches that polymerization is performed using similar conditions-i.e. solution polymerization system, similar temperature, etc.- as used by applicant to prepare component (a) of the claimed invention for the inventive examples. As the prior art propylene (co)polymer is prepared

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by polymerizing the same monomers using the same catalysts under similar conditions as the claimed invention, the examiner takes the position that the properties of the prior art propylene (co)polymer would necessarily be the same as claimed and inherently be not materially different from those of the claimed invention. Applicant is therefore required to provide factual evidence demonstrating that the prior art propylene (co)polymer is not inherently characterized by a polydispersity index in the claimed range (for claims 14, 28, 29).

9. Pelliconi specifically teaches that the bridged bis-indenyl metallocene catalysts disclosed by Winter are particularly used for the production of copolymer (a) and copolymer (b) of the composition of WO 03/051984 (Page 5, line 26, to Page 6, line 1). As Winter is explicitly cited, it would therefore have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Pelliconi by using the bridged bis-indenyl metallocene catalyst of Winter for the preparation of copolymer (a), which corresponds to claimed component (c), with the reasonable expectation of preparing a polymer composition having the balance of processability, mechanical properties, and optical properties disclosed by Pelliconi.

### ***Response to Arguments***

10. Applicant's arguments filed 01/15/2009 have been fully considered but they are not persuasive.

11. Regarding the catalyst used: "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-

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preferred embodiments," *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.). Also, "[D]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments," *In re Susi* 440 F.2d 442, 169 USPQ 423 (CCPA 1971). (MPEP § 2123 [R-5]). As discussed in previous Office Actions, Pelliconi preference for the use of Ziegler-Natta catalysts does not constitute a teaching away from the reference's broader disclosure that metallocene catalysts may be used. Furthermore, it is insufficient to argue that Pelliconi recites a broad range of catalysts for use in preparing the composition of WO 03/051984. Barring a showing of factual evidence demonstrating unexpected results, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use any of the catalysts disclosed by Pelliconi as suitable for use in preparing components of the prior art composition. The examiner maintains the position that Pelliconi's specific recitation that the catalysts disclosed by Winter may be used to prepare copolymers (a) and (b) renders the use of these catalysts for the preparation of the prior art copolymer (a) *prima facie* obvious.

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

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1971). As discussed in the previous Office Actions and above, Pelliconi explicitly cites Winter as teaching metallocene catalysts which may be used in the production of the composition of WO 03/051984; Pelliconi further explicitly states that such metallocene catalysts are particularly suited for the preparation of copolymer (a) and copolymer (b). Contrary to applicant's assertion, impermissible hindsight would not be required for one of ordinary skill in the art to use a catalyst taught by a reference that Pelliconi explicitly cites, for the very same purpose for which Pelliconi specifically states the catalysts of said reference may be used.

13. Regarding the allegedly unexpected results: Unexpected results cannot be the result of a property or limitation that is anticipated by the prior art reference; rather, unexpected results must be due to a difference between the claimed invention and the prior art. Polydispersity index is known to be dependent on the type of catalyst used to prepare a polymer. As discussed earlier in this Office Action, Pelliconi teaches that the propylene (co)polymer component of the composition of WO 03/051984 is prepared by (co)polymerizing propylene using the same Ziegler-Natta type catalysts and similar polymerization conditions as used by applicant to prepare claimed component (a); it is therefore reasonably expected that the polydispersity index of the prior art (co)polymer is the same as claimed component (a). The difference between the prior art composition and the claimed invention therefore is not the polydispersity index of claimed component (a); rather, the difference is the choice of catalyst used to prepare claimed component (c). The examiner notes that Examples 1 and 3, the only Comparative examples provided in the specification, both disclose compositions

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wherein component (c) is prepared using the same catalyst as component (c) in the inventive examples. Applicant therefore has not demonstrated that unexpected results are obtained based on a difference between the claimed invention and the prior art.

14. Furthermore, the examiner notes that the allegedly unexpected results would not be commensurate in scope with the claimed invention with regards to the polydispersity index. The inventive examples disclose compositions wherein the polydispersity index of component (a) is 3.8 or 5; the comparative examples contain component (a) having polydispersity of 2.4. As the polydispersity of the comparative examples is closer to the claimed limit of 3 than that of the inventive examples, the provided examples would not be sufficient to establish the criticality of the claimed range and therefore are not commensurate in scope with the invention as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/  
Supervisory Patent Examiner, Art Unit 1796

/Jeffrey Lenihan/  
Examiner, Art Unit 1796

/JL/